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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,874	10/12/2006	Thomas Nissl	NISSL-3	5933
20151 7590 05/27/2010 HENRY M FEIEREISEN, LLC HENRY M FEIEREISEN 708 THIRD AVENUE SUITE 1501 NEW YORK, NY 10017				
EXAMINER				
BONK, TERESA				
ART UNIT		PAPER NUMBER		
3725				
NOTIFICATION DATE		DELIVERY MODE		
05/27/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

INFO@FEIEREISENLLC.COM

### Office Action Summary

**Application No.**

10/599,874

**Applicant(s)**

NISSL, THOMAS

**Examiner**

Teresa M. Bonk

**Art Unit**

3725

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8, 10-18 and 20 is/are rejected.
- 7) ☒ Claim(s) 7, 9, 19, 21 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 February 2010 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Drawings***

The drawings were received on February 18, 2010. These drawings are acceptable.

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1-6 and 10-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Van Leer et al. (hereafter “Van Leer”) (US Patent 3,051,112), newly cited.**

With regards to **claim 1**, Van Leer discloses an apparatus comprising radially inwardly moving segmental compressors (stops 80, 80a) which act, at least indirectly, radially on an outer surface of the workpiece and are supported on a circumferential abutment (60, 68 as seen in Figures 2, 4, and 4a), flexible tensioning members (rubber blanket 35, 95, plurality members shown in Figure 10) provided between the compressors and the abutment and expandable by a

pressure fluid in opposition to a resiliently elastic rebound force, as seen in Figure 6-10 [Column 5, lines 33-50 and Column 6, lines 65+].

The phrase “for reducing the diameter of a stent” is considered to be a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

It is noted that the claims state “circumferential abutment” while the original specification has support only for “cylindrical abutment,” Paragraphs 0035, 0042, and 0043. “Cylindrical abutment” can be read as a cam surface or machine base that backs up an expandable means; therefore, as long as an expandable member acts between a die or tool and a backup with at least two punches/dies (segmental) this claim is met.

With regards to **claim 2**, Van Leer discloses wherein the tensioning members are formed by a balloon or expandable tubes, as seen in Figures 6-10 [Column 3, lines 42-47].

With regards to **claim 3**, Van Leer discloses wherein the compressors have concave contact surfaces (81) in a direction towards the circumferential abutment, and wherein the abutment has concavely curved resistance surfaces (67/67a), which are open towards a center axis of the abutment for the tensioning members, as seen in Figures 6 and 7.

With regards to **claim 4**, Van Leer discloses wherein the compressors are disposed in at least two parallel planes and radially movable in each plane independently of compressors of a neighboring plane, as seen in Figures 4 and 4a.

With regards to **claim 5**, Van Leer discloses wherein the abutment extends across all planes, as seen in Figures 2 and 3.

With regards to **claim 6**, Van Leer discloses wherein each of the compressors embraces a radially inwardly extending strut (6) of the abutment and is supported resiliently elastically upon the strut, as seen in Figure 7 [Column 4, lines 1-10].

With regards to **claim 10**, Van Leer discloses an apparatus comprising: a compressor (stops 80, 80a) constructed to move radially inwardly to act, at least indirectly, radially upon an outer surface of a workpiece; an abutment for support of the compressor (60, 68 as seen in Figures 2, 4, and 4a); a resiliently elastic rebound mechanism [Column 5, lines 25-32]; and a flexible tensioning member (rubber blanket 35) arranged between the abutment and the compressor and rendered operative to expand by pressure fluid in opposition to a force applied by the rebound mechanism, as seen in Figure 4.

With regards to **claims 11 and 12**, Van Leer discloses wherein the tensioning members are formed by a balloon or expandable tubes, as seen in Figures 6-10 [Column 3, lines 42-47].

With regards to **claim 13**, Van Leer discloses wherein the abutment is defined by a center axis (Figures 2 and 3), the compressors have concave contact surfaces (81) in a direction towards the abutment, and the abutment having a complementary concavely curved resistance surfaces (67/67a), which are open towards the center axis of the abutment for the tensioning members, as seen in Figures 6 and 7.

With regards to **claim 14**, Van Leer discloses wherein the compressors are disposed in at least two parallel planes and radially movable in each plane independently of compressors of a neighboring plane, as seen in Figures 4 and 4a.

With regards to **claim 15**, Van Leer discloses wherein the compressors are positioned about a circle, with the abutment disposed in surrounding relationship to the compressors.

With regards to **claim 16**, Van Leer discloses wherein the abutment extends across all planes, as seen in Figures 2 and 3.

With regards to **claim 17**, Van Leer discloses wherein the abutment has a cylindrical configuration.

With regards to **claim 18**, Van Leer discloses wherein each of the compressors embraces a radially inwardly extending strut (6) of the abutment and is supported resiliently elastically upon the strut, as seen in Figure 7 [Column 4, lines 1-10].

**Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kojima et al. (hereafter “Kojima”) (US Patent 3,051,112), newly cited.**

With regards to **claim 1**, Kojima discloses an apparatus comprising radially inwardly moving segmental compressors (43, 44) which act, at least indirectly, radially on an outer surface of the workpiece and are supported on a circumferential abutment (52 as seen in Figures 1a and 1b), flexible tensioning members [pins 60, it is noted that the pins are resilient, as even steel has resiliency] provided between the compressors and the abutment and expandable by a pressure fluid in opposition to a resiliently elastic rebound force (8).

The phrase “for reducing the diameter of a stent” is considered to be a recitation of intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the

intended use, then it meets the claim. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

It is noted that the claims state “circumferential abutment” while the original specification has support only for “cylindrical abutment,” Paragraphs 0035, 0042, and 0043. “Cylindrical abutment” can be read as a cam surface or machine base that backs up an expandable means; therefore, as long as an expandable member acts between a die or tool and a backup with at least two punches/dies (segmental) this claim is met.

With regards to **claim 4**, Kojima discloses wherein the compressors are disposed in at least two parallel planes and radially movable in each plane independently of compressors of a neighboring plane, as seen in Figures 1a and 1b.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 8 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Van Leer in view of Kokish (Pub. No. US 2003/0070469), previously presented.**

Van Leer discloses the invention substantially as claimed except for wherein the compressors are made of plastic and the abutment is made of metal. Kokish is relied upon to teach that stent crimping assemblies may be formed of plastic and metal parts including a combination of both [Paragraph 0057]. Therefore, it would have been obvious to one of ordinary

skill in the art at the time the invention was made to have the elements made of the particular materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanically efficiency.

**Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kojima in view of Kokish (Pub. No. US 2003/0070469), previously presented.**

Kojima discloses the invention substantially as claimed except for wherein the compressors are made of plastic and the abutment is made of metal. Kokish is relied upon to teach that stent crimping assemblies may be formed of plastic and metal parts including a combination of both [Paragraph 0057]. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the elements made of the particular materials since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of mechanically efficiency.

***Allowable Subject Matter***

Claims 7, 9, 19, and 21-22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Teresa M. Bonk whose telephone number is (571)272-1901. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on 571-272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Teresa M. Bonk/  
Examiner, Art Unit 3725